

**REMARKS**

Claims 1-21 were pending in this application.

Claims 1-21 have been rejected.

Claims 1, 6, 8, 13, 15, and 20 have been amended as shown above.

Claims 22 and 23 have been added.

Claims 1-23 are now pending in this application.

Reconsideration and full allowance of Claims 1-23 are respectfully requested.

**I. REJECTION UNDER 35 U.S.C. § 112**

The Office Action rejects Claims 1-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. In particular, the Office Action asserts that Claims 1, 8, and 15 are misdescriptive because of a lack of an essential element.

The Applicants have amended Claims 1 and 8 to recite a “peak-to-peak detector” capable of “limiting an amplitude of [an] FSK signal to produce a limited FSK signal.” The Applicants have also amended Claim 15 to recite “limiting an amplitude of [an] FSK signal to produce a limited FSK signal.” The Applicants respectfully submit that Claims 1, 8, and 15 are definite and distinctly claim the subject matter regarded as the invention.

Accordingly, the Applicants respectfully request withdrawal of the § 112 rejection.

## II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-7 and 15-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,396,888 to Notani et al. (“*Notani*”). The Office Action rejects Claims 8-14 under 35 U.S.C. § 103(a) as being unpatentable over *Notani* in view of U.S. Patent No. 5,319,679 to Bagby (“*Bagby*”). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of

obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP* § 2142).

*Notani* recites a clock recovery circuit for use in a transmission system. (*Col. 18, Lines 25-26; Abstract*). In *Notani*, multiple "variable delay lines" (elements 71 through 7N) process clock signals and generate delayed clock signals. (*Col. 18, Lines 38-41*). The delayed clock signals are then fed through OR gates. (*Col. 18, Lines 41-44*). The clock signals provided to the variable delay lines are transmitted by "transmitting portions" (elements 30\_1 through 30\_N) and received by "receiving portions" (elements 40\_1 through 40\_N). (*Col. 17, Lines 51-55*).

*Notani* simply recites that the variable delay lines receive clock signals transmitted by a transmitter. *Notani* lacks any mention that the signals provided to the variable delay lines are first provided to a "peak-to-peak detector" capable of "limiting an amplitude" of the clock signals. As a result, *Notani* fails to disclose, teach, or suggest a "peak-to-peak detector" capable of "limiting an amplitude of [an] FSK signal to produce a limited FSK signal" as recited in Claims 1 and 8. *Notani* also fails to disclose, teach, or suggest "limiting an amplitude of [an] FSK signal to produce a limited FSK signal" as recited in Claim 15.

*Bagby* is cited by the Office Action as allegedly disclosing demodulation circuitry.

*Bagby* is not relied upon as disclosing, teaching, or suggesting any other elements of Claims 1, 8, and 15.

For these reasons, *Notani* does not disclose, teach, or suggest the Applicants' invention as recited in Claims 1 and 15 (and their dependent claims). Also, the proposed *Notani-Bagby* combination does not disclose, teach, or suggest the Applicants' invention as recited in Claim 8 (and its dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 1-21.

### III. NEW CLAIMS

The Applicants have added new Claims 22 and 23. The Applicants respectfully submit that no new matter has been added. The Applicants respectfully request entry and full allowance of Claims 22 and 23.

### IV. CONCLUSION

For the reasons given above, the Applicants respectfully request reconsideration and full allowance of all pending claims and that this application be passed to issue.

**SUMMARY**


If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Applicants have included the appropriate fee to cover the cost of this AMENDMENT AND RESPONSE. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: Dec. 22, 2004

  
\_\_\_\_\_  
William A. Munck  
Registration No. 39,308

P.O. Drawer 800889  
Dallas, Texas 75380  
(972) 628-3600 (main number)  
(972) 628-3616 (fax)  
E-mail: *wmunck@davismunck.com*